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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,480	10/28/2004	Jeffrey W. Scott	SILA:057C1	8093

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EXAMINER

SINGH, RAMNANDAN P

ART UNIT PAPER NUMBER

2646

DATE MAILED: 07/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/629,480

Applicant(s)

SCOTT ET AL.

Examiner

Ramnandan Singh

Art Unit

2646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>July 29, 2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. **Preliminary Amendment**

The Preliminary amendment to the Specification, filed on Oct. 28, 2004, on page 2, lines 1-2 is not approved. This is because it recites the amendment " This application is a continuation of co-pending U.S. Serial No. 09/470,973 filed on December 22, 1999 which is INCORRECT. This is because the instant application is NOT a continuation of co-pending U.S. Serial No. 09/470,973 filed on December 22, 1999. Furthermore, they are not related. Appropriate correction is required.

2. **Status of Claims**

Claims 10-35 are cancelled.

Claims 1-9 are pending.

Double Patenting

3. **ANALYSIS:**

To demonstrate that the instant application S/N: 10/629,480 and U.S. patent No. 6,385,235 B1 are claiming common subject matter, a brief analysis is presented below:

(i) Claim 1 of the Instant Application: Circuitry for terminating a phone line connection, comprising:

powered side circuitry operable to communicate digitally with phone line side circuitry, said digital communication comprising a digital data stream;

phone line side circuitry operable to communicate digitally with powered side circuitry, said digital communication between said powered side circuitry and said phone line side circuitry comprising a digital data stream transmitted through an isolation barrier; and

encode and decode circuitry coupled to said digital data stream to generate an encoded digital signal for transmission and receipt across said isolation barrier.

(ii) Claim 1 of U.S. Patent No. 6,385,235 B1: Digital direct access arrangement circuitry for terminating a phone line connection, comprising:

powered side circuitry operable to communicate digitally with phone line side circuitry, said digital communication comprising a digital data stream in a pulse density modulation format transmitted across an isolation barrier;

phone line side circuitry operable to communicate digitally with powered side circuitry, said digital communication being in a pulse density modulation format transmitted across said isolation barrier; and

encode and decode circuitry coupled to said digital data stream to generate an encoded digital signal for transmission and receipt across said isolation barrier, wherein said encoded digital signal comprises control data added to said digital data stream.

(iii) Comparing claim 1 of the instant application with claim 1 of U.S. Patent No. 6,385,235 B1, it is obvious that, in both inventions, the circuitry for terminating a phone line connection is operable between the powered side circuitry and the phone line side circuitry comprising a digital data stream through an isolation barrier. Hence, both claimed inventions are claiming a common subject matter.

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-9 are rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-5 of U. S. Patent No. 6,385,235 B1, since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: Claim 1 of the instant application is a broad version of claim 1 of U.S. Patent No. 6,385,235 B1 because claim 1 of U.S. Patent No. 6,385,235 B1 contains all the limitations of claim 1 of the instant application.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-2, 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Mills [US 5,815,505].

Regarding claim 1, Mills teaches circuitry for terminating a phone line connection, as shown in Fig. 3, comprising:

powered side circuitry (210) operable to communicate digitally (205) with phone line side circuitry (208), the digital communication comprising a digital data stream;

the phone line side circuitry operable (210) to communicate digitally with the powered side circuitry (208), the digital communication between the powered side circuitry and the phone line side circuitry comprising a digital data stream transmitted

through an isolation barrier (206) (i.e. data access arrangement (DAA)) [Fig. 3; col. 5, lines 30-61; col. 9, lines 39-48]; and

encode and decode circuitry [col. 6, line 59 to col. 7, line 12; col. 11, lines 8-17] coupled to the digital data stream to generate an encoded digital signal for transmission and receipt across the isolation barrier [Figs. 1, 3; col. 2, line 62 to col. 3, line 17; col. 4, line 56 to col. 5, line 15; col. 1, lines 55-58; col. 8, lines 17-21; col. 10, line 48 to col. 11, line 17; col. 13, line 28 to col. 14, line 32].

Regarding claim 2, Mills further teaches the circuitry, comprising DSL (40) circuitry that may be used to generate ADSL (a variant of DSL) information for transmission across the isolation barrier (207) [Fig. 1; col. 2, lines 62 to col. 17; col. 4, line 56 to col. 5, line 16; col. 11, lines 8-17].

Regarding claim 6, the limitation is shown above.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 3-5 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mills as applied to claims 2 and 6 respectively above, and further in view of Hershbarger et al [US 5,654,984].

Regarding claim 3, although Mills teaches a data access arrangement (DAA) as an isolation barrier [Fig. 3; col. 5, lines 56-61; col. 9, lines 39-48], he does not disclose details about the components of the DAA. As a result, one of ordinary skill in the art would have been motivated to seek any known circuit of the DAA that may function as an isolation barrier between powered side circuitry and phone line side circuitry, operable to communicate digitally across the DAA, such as Hershbarger et al.

Hershbarger et al teaches a DAA circuitry, wherein the isolation barrier is comprised of one or more capacitors [Fig. 2].

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the teachings of Hershbarger et al with Mills in order to construct the DAA circuitry of Mills.

Regarding claims 4-5, Hershbarger et al further teach the DAA circuitry wherein isolation barrier is comprised of a transformer and one or more capacitors [Figs. 1, 3].

Regarding claim 7, Hershberger et al further teach the DAA circuitry wherein isolation barrier is comprised of a transformer [Fig. 1].

Regarding claims 8-9, the limitations are shown above.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hamdi [US 20010002902 A1] teaches a multipoint digital simultaneous voice and data transmission [Fig. 3; Para: 0011; 0044; 0046; 0048; 0051; 0054-0056].

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramnandan Singh whose telephone number is (571) 272-7529. The examiner can normally be reached on M-TH (8:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tran Sinh can be reached on (571) 272-7564. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ramnandan Singh
Examiner
Art Unit 2646



SINH TRAN
SUPERVISORY PATENT EXAMINER